

REMARKS

Applicants have carefully considered the February 2, 2006 Office Action, and the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance.

Claims 1-29 are pending in this application. Claim 29 has been withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Claims 1, 3-21 and 23-28 have been rejected. Entry of the present Request for Reconsideration is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 1, 3-21 and 23-28 were rejected under 35 U.S.C. § 112, first paragraph. The Examiner asserted that there is no support in the specification for the claim phrase “the bending member is configured to bend the open envelope about an axis that is substantially perpendicular to a joint between the flap and the open envelope” as recited in independent claims 1 and 21. Applicants respectfully traverse.

The written description inquiry is a factual one and must be assessed on a case-by-case basis. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) (quoting *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) (“Precisely how close the original description must come to comply with the description requirement of § 112 must be determined on a case-by-case basis.”)). In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide in *haec verba* support for the claimed subject matter at issue. *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996). Nonetheless, the disclosure must convey with reasonable clarity to those skilled in the art that the inventor was in possession of the invention. *Vas-Cath Inc.*, 935

F.2d at 1563-64, 19 USPQ2d at 1116-17. As such, the written description requirement is satisfied if one skilled in the art, reading the original disclosure, would have reasonably discerned the limitation at issue in the claims. *Waldemar Link GmbH & Co. v. Osteonics Corp.*, 32 F.3d 556, 558, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994). In applying the above legal tenets to the exigencies of this case, Applicants submit that one having ordinary skill in the art, reading the original disclosure, would have reasonably discerned the above stated claim limitation.

It is initially noted that the claim limitation identified by the Examiner was present in originally filed claims 2 and 22. In the Amendment previously submitted on December 6, 2005, the subject matter of claims 2 and 22 was incorporated into claims 1 and 21, respectively. The originally filed claims are part of the original written description.

Moreover, Applicants refer the Examiner to page 6, first full paragraph of the Detailed Description section, wherein it is described that the present subject matter improves control of a flap on an envelope in an envelope packing or inserting system by bending the envelope about an axis that is substantially perpendicular to a connecting edge between the flap and an envelope body of the envelope. Figs. 3A and 3B respectively illustrate the cross-sections of an envelope when the envelope is flat and when the envelope is bent. These cross-sections are taken along a x-axis, which is substantially parallel to the connecting edge of the envelope.

Further, the Examiner's attention is directed to page 8, second full paragraph of the Detailed Description section, wherein the conveyor 50 (Fig. 6) is described. The conveyor 50 depicted in Fig. 6 comprises a packing station wherein an object or packet, broadly characterized as insertion materials, may be inserted into a conveyed open envelope 4. The packing station comprises the portion of the conveyor which includes the single rail 54 (bending member). The rail 54 is configured to impart a bend in a conveyed open envelope 4 by displacing a center

portion of the open envelope relative to widthwise distal end portions of the open envelope and to maintain a bend in the conveyed envelope until the envelope is gripped by a gripping device (not shown) in such a manner as to provide access to an interior of the envelope or until an object is at least partially inserted into an interior of the envelope.

Therefore, in view of the foregoing Applicants respectfully submit that the specification fully describes a bending member configured to bend an open envelope about an axis that is substantially perpendicular to a joint between the flap and the open envelope. Indeed, the claim limitation at issue is described in such a reasonable way that would have been recognized by one having ordinary skill in the art. Clearly, Applicants were in possession of the bending member concept and recognize its inventiveness since they recited it in the original claims. Accordingly, the rejection is not legally viable and should be withdrawn.

Claims 1, 3, 9, 10 and 17-21 were rejected under 35 U.S.C. § 102(b) as being anticipated over Long et al. (U.S. Pat. No. 5,457,941, hereinafter “Long”). Applicants respectfully traverse the rejection.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. In imposing a rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. Applicants submit that there are significant differences between the claimed subject matter and the device disclosed by Long that would preclude the factual determination that Long identically describes the claimed subject matter within the meaning of 35 U.S.C. § 102.

Independent claims 1 and 21 both describe, in pertinent part, that the bending member is configured to bend the open envelope about an axis that is substantially perpendicular to a joint between the flap and the open envelope. In contrast, as depicted in FIG. 6B, Long discloses an envelope stuffing device with feed belts 50a, 50b and 52 used to bend the envelope along its length. Long's feed belts 50a, 50b and 52 bend the envelope about an axis that is parallel to the joint between the flap and the envelope. Long, therefore, fails to disclose a bending member configured to bend an open envelope about an axis that is substantially perpendicular to a joint between the flap and the open envelope. Thus, Long fails to identically disclose or suggest every limitation of independent claims 1 and 21. Accordingly, Applicants submit that the Examiner's rejection under 35 U.S.C. § 102(b) is factually and legally erroneous and should be withdrawn.

In response to Applicants arguments submitted on December 6, 2006, the Examiner at page 7 of the Office action, stated that claims 1 and 21 do not positively recite that "the bending member is configured to bend the open envelope about an axis that is substantially perpendicular to a joint between the flap and the open envelope" since Applicants use the terms "about" and "substantially". Moreover, the Examiner at page 8 of the Office action, stated that FIG. 6B of Long discloses that the bending member 52 is configured to bend the open envelope 14 about an axis that is substantially perpendicular to a joint between the flap and the open envelope via the axis perpendicular to any joint between the flap and the open envelope. Applicants respectfully traverse.

The plain meaning of term "about" as used in the above quoted phrase in claims 1 and 21 is intended to mean "in relation to" or "with reference to" and not "approximately" or "nearly" as is believed to be suggested by the Examiner. Moreover, the plain meaning of the term "substantially" is intended to mean "considerably" or "significantly". Thus, Applicants fail to

understand the Examiner's position that the claim terms "about" and "substantially" somehow erase the express limitations positively recited in claims 1 and 21.

Additionally, the Examiner's beliefs are inconsistent with the disclosure of the Long patent. As clearly depicted in FIG. 6B of Long, an envelope stuffing device is shown with feed belts 50a, 50b and 52 used to bend the envelope along its length not its width. In other words, Long's upper feed belt 52 in conjunction with the lower feed belts 50a and 50b, bend the envelope about an axis that is parallel to the joint between the flap and the envelope -- not substantially perpendicular as required in claims 1 and 21.

Accordingly, in view of the foregoing, Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(b) is factually and legally erroneous and should be withdrawn.

Dependent claims 11, 15, 16 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Long. Applicants respectfully traverse the rejection of claims 11, 15, 16 and 23. Applicants incorporate herein the arguments previously advanced in traversal of the rejection of claims 1, 3, 9, 10 and 17-22 under 35 U.S.C. § 102(b) predicated upon Long. The modification to Long proposed in the 103 rejection would not lead an artisan to orient the bending member as claimed or otherwise lead to an arrangement that meet the requirements of the independent claims. Dependent claims 11, 15, 16 and 23 are patentably distinct over the applied reference in view of their dependencies from either independent claim 1 or 21. Accordingly, the rejection is not legally viable and should be withdrawn.

Dependent claims 4-8, 12-14 and 24-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Long in view of Haas et al. (U.S. Pat. No. 4,798,040, hereinafter "Haas"). Applicants respectfully traverse. Applicants incorporate herein the arguments previously advanced in traversal of the rejection of claims 1, 3, 9, 10 and 17-22 under 35 U.S.C. § 102(b)

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predicated upon Long. The secondary reference to Haas does not cure the argued deficiency of Long. Thus, even if the applied references are combined as suggested by the Examiner, the claimed subject matter will not result. Accordingly, the rejection is not legally viable and should be withdrawn.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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